

## REMARKS

Forty-three claims were originally filed in the present Application. Claims 1-4, 6-18, 20-24, 26-38, and 40-43 currently stand rejected. Claims 1, 4, 6-8, 20, 21, 24, 26-28, and 40 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

### Finality Of The Current Office Action

On page 15 of the present Office Action, the Examiner states that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL.” Applicants respectfully disagree. Applicants submit that the grounds of rejection in the present Final Office Action appear to be the same as those found in the first Office Action. In addition, as stated in the prior Response to Office Action which amended claims 1 and 21, *“the foregoing amendments are supported by claims 5, 19, 20, 25, 39, and 40, as originally filed, and therefore do not necessitate a new search.”* Applicants respectfully submit that the finality of the current Office Action is improper because the Applicants’ amendment of claims 1 and 21 in the prior Office Action only incorporated selected limitations from the originally-filed dependent claims. In light of the foregoing comments, Applicants submit that the finality of the present Office Action is not appropriate. Applicants therefore respectfully request the Examiner to withdraw the finality of the present Office Action.

### Claim Objections

On page 5 of the Office Action, the Examiner objects to claims 6-18, 20, 26-38, and 40 because of various “informalities”. Accordingly, Applicants herein amend claims 6, 20, 26, and 40 to correct the foregoing informalities. Applicants therefore request the Examiner to withdraw the objections to claims 6-18, 20, 26-38, and 40.

### Rejection under 35 U.S.C. §112, Second Paragraph

On page 6 of the Office Action, the Examiner indicates that claims 1-4, 6-18, 20-24, 26-38, 40, and 41 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner states that the meets and bounds of the limitation “minimal configuration to reduce manufacturing costs of said peripheral device” are not found to be set forth and clearly defined in the specification. Applicants respectfully disagree. Applicants refer the Examiner to their discussion of FIG. 7 found on page 13, line 14 through page 15, line 7, of the Specification. The Applicants’ discussion of FIG. 7 describes in detail one embodiment of the claimed “peripheral device” with an exemplary “minimal configuration” that is clearly defined.

On page 6 of the Office Action, the Examiner also states that the meets and bounds of the limitation “sufficient computing capabilities to effectively process, store, and manage said information” are not found to be set forth and clearly

defined in the specification.” Applicants again respectfully disagree. Applicants refer the Examiner to their discussion of FIGS. 3-5 found on page 8, line 13 through page 11, line 17, of the Specification. The Applicants’ discussion of FIGS. 3-5 describes in detail one embodiment of the claimed “control device” with exemplary “computing capabilities” that are clearly defined. In view of the foregoing remarks, Applicants believe that the Examiner’s rejections are addressed, and respectfully request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn so that the claims may issue in a timely manner.

35 U.S.C. § 102(b)

On page 6 of the Office Action, the Examiner rejects claims 1-4, 6-13, 20-24, 26-33, and 40-43 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,479,206 to Ueno et al. (hereafter Ueno). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Ueno fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 21 which are amended to recite “*said peripheral device being*

*implemented with a minimal configuration that does not perform processing functions on said information, said minimal configuration reducing manufacturing costs of said peripheral device” and “said control device being implemented as a camera device that includes sufficient computing capabilities to effectively process, store, and manage said information instead of utilizing said peripheral device to process, store, and manage said information,”* which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Ueno teaches using a desktop computer system to download image data captured by an electronic camera that includes signal processing and local memory resources (see FIGS. 1 and 2). The Examiner apparently analogizes the desktop computer system of Ueno to Applicants’ claimed “camera device”, and also analogizes the camera of Ueno to Applicants’ claimed “peripheral device”.

Applicants submit that their portable “camera device” is not properly analogous to a stationary desktop computer system that has no actual camera functionality. Furthermore, Applicants submit that their minimal “peripheral device” is not properly analogous to Ueno’s camera that includes a substantial main memory, a camera control unit, and a camera signal processor for performing processing functions on the captured information. Therefore, for at least the foregoing reasons, Applicants submit that amended claims 1 and 21 are not anticipated by the teachings of Ueno.

With regard to claim 43, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those

remarks by reference with regard to claim 43. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 43, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Ueno and Applicants’ invention as disclosed in the Specification, claim 43 is therefore not anticipated or made obvious by the teachings of Ueno.

Regarding the Examiner’s rejection of dependent claims 2-4, 6-13, 20, 22-24, 26-33, 40, and 41, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 6-13, 20, 22-24, 26-33, 40, and 41, so that these claims may issue in a timely manner.

Furthermore, in the prior Office Action, with respect to the rejections of claims 12-13 and 32-33 under 35 U.S.C. 103, the previous Examiner has already conceded on the record that Ueno “doesn’t explicitly teach that it is economically designed, that does not include substantial data manipulation capabilities.” Applicants concur. However, the current Examiner in the present Office Action has rejected claims 12-13 and 32-33 under 35 U.S.C. §102.

Applicants submit that a valid rejection under 35 U.S.C. §102 requires that all claimed limitations be present in the cited reference. Applicants submit that since, by the prior Examiner's own admission, Ueno "doesn't explicitly teach that it is economically designed, that does not include substantial data manipulation capabilities," therefore, the present rejections of claims 12-13 and 32-33 are improper.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Ueno to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-4, 6-13, 20-24, 26-33, and 40-43, so that these claims may issue in a timely manner.

### 35 U.S.C. § 103

On page 10 of the Office Action, the Examiner rejects claims 14-15, 17-18, 34-35, and 37-38 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,479,206 to Ueno et al. (hereafter Ueno), in view of U.S. Patent No. 6,714,238 to Urisaka et al. (hereafter Urisaka). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Ueno according to the teachings of Urisaka would produce the claimed invention. Applicants submit that Ueno in combination with Urisaka fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Ueno nor Urisaka contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Further regarding the Examiner's rejection of dependent claims 14-15, 17-18, 34-35, and 37-38, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 14-15, 17-18, 34-35, and 37-38 so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 14-15, 17-18, 34-35, and 37-38 are not unpatentable under 35 U.S.C. § 103 over Ueno in view of Urisaka, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 14-15, 17-18, 34-35, and 37-38 under 35 U.S.C. § 103.

On page 14 of the Office Action, the Examiner rejects claims 16 and 36 under 35 U.S.C. § 103 as being unpatentable over Ueno in view of Urisaka, and further in view of U.S. Patent No. 6,230,319 to Britt Jr. et al. (hereafter Britt). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 16 and 36, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also



not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 16 and 36 so that these claims may issue in a timely manner.

Also with regard to the rejection of claims 16 and 36, the Examiner states that “[t]herefore, it would have been obvious to one in the ordinary skill in the art to have been motivated to configure the obvious combination . . . in order to update the camera device with new features . . . .” Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

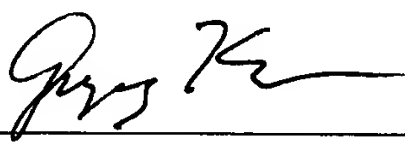
For at least the foregoing reasons, the Applicants submit that claims 16 and 36 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 16 and 36 under 35 U.S.C. § 103.

### Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102 and 35 U.S.C. §103. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-4, 6-18, 20-24, 26-38, and 40-43, so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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